

### REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

Before addressing each of the issues raised in the outstanding Office Action, the undersigned would first like to thank Examiner Pardo for courtesies extended during a telephone interview on March 10, 2006 (referred to as "the telephone interview"). During the telephone interview, needs addressed by the present invention were discussed, independent claims 1 and 15 were discussed, and U.S. Patent Application Publication No. 2002/0147646 (referred to as "the Ogura publication") was discussed.

### Objections

The abstract is objected to as exceeding 150 words. The abstract has been amended and no longer exceeds 150 words. Accordingly, this objection should be withdrawn.

## Rejections under 35 U.S.C. § 102

Claims 1-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Ogura publication. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing various patentable features of the claimed invention, the Ogura publication is first introduced. As discussed during the telephone interview, embodiments discussed in the Ogura publication concern printed ads (e.g., handbills) and coupons targeted to users (See, e.g., paragraphs [0154] and [0165].), not to document content. Generally, the Ogura publication uses a registration process and a printing process. (See, e.g., paragraph [0161].) During the registration process, a head shop server 3 finds ad information for a user and sends a message concerning the ad to the user's telephone or email device 1. (See, e.g., paragraphs [0162]-[0192].) If the user performs various actions, print ad request information is transmitted to a printing server 2 where it is stored. (See, e.g., paragraphs [0193]-[0203].)

In the printing process, when a user later visits a particular shop, a multi-function printer ("MFP") 60 can request, from the printing server 2, the previously stored ad request information so that it can print out a handbill ad or coupon. (See, e.g., the Abstract, and paragraphs [0011], [0160]-[0222].)

As can be appreciated from the foregoing, the ads in Ogura are printed (e.g., handbills, coupons, etc.). The

ads are targeted to users, not based on an analysis of their relevance to content of an e-mail.

Exemplary embodiments consistent with the present invention determine ads relevant to the content of an email, such as an email newsletter for example. Such embodiments might not rely on JavaScript and IFRAMES since such information might be removed by certain email services. The ads might be determined at the time an end user opens the email, so that current information is used in an arbitration of competing ads. Multiple ads might be provided in a single image, and a position of a cursor at the time of a user selection might be used to determine which of the multiple ads was selected (e.g., for purposes of ad performance tracking, advertiser billing, loading an ad landing page, etc.) by the user. A unique identifier (e.g., a content unique identifier ("CUID")) may be used to match an email document generating an ad request, with an earlier registration pertaining to the content of the email. Such a unique identifier might also be used to match user actions to particular ads.

Having introduced both the Ogura publication and exemplary embodiments consistent with the present invention, at least some of the patentable features of the claimed invention are now discussed. Independent claims 1, 8, and 15 are not anticipated by the Ogura publication at least because the cited portions of the Ogura publication do not teach acts of, or means for, (i) accepting by a content-relevant ad server and/or sending from a client device, *a document identifier* in an ad request, (ii) using *content-relevance information* associated with the document identifier and ad

information to determine a set of one or more ads, and (iii) accepting by a content-relevant ad server and/or sending from a client device, a session identifier (identifying a generated image including one or more ads and served to a client device) and **position information** as claimed. Each of these patentable differences is addressed below.

First, independent claims 1, 8, and 15 are not anticipated by the Ogura publication because the cited portions of the Ogura publication do not teach acts of, or means for, accepting by a content-relevant ad server and/or providing from a client device, **a document identifier** in an ad request. The Examiner contends that Figures 47 and 63, and paragraphs [0082]-[0084] of the Ogura publication teach this feature because an ad is displayed on an email receiving portion of a portable telephone. (See, Paper No. 120505, page 3.) However, the display of an ad on a portable telephone does not teach accepting by a content-relevant ad server and/or sending from a client device, **a document identifier** in an ad request. Thus, independent claims 1, 8 and 15 are not anticipated by the Ogura publication for at least this reason. Since claims 2-7 depend, either directly or indirectly, from claim 1, since claims 9-14 depend, either directly or indirectly, from claim 8, and since claims 16-21 depend, either directly or indirectly, from claim 15, these claims are similarly not anticipated by the Ogura patent.

Second, independent claims 1, 8, and 15 are not anticipated by the Ogura publication at least because the cited portions of the Ogura publication do not teach acts of, or means for, **using content-relevance information**

*associated with the document identifier* and ad information *to determine a set of one or more ads*. The Examiner cites paragraphs [0167] and [0168] of the Ogura publication as teaching this feature. (See, Paper No. 120505, page 3.) As discussed during the telephone interview, embodiments consistent with the present invention use content of an email document (which may have been previously registered by an email newsletter publisher for example) to determine ads relevant to such content. The content-relevant ad server uses the document identifier to obtain content-relevance information, which is then used to determine a set of one or more ads relevant to the content.

On the other hand, as can be appreciated from paragraphs [0162]-[0169] of the Ogura publication, the ads are relevant to the user identified, not to the content of the email sent to the user terminal. Indeed, the content of the email sent to the user terminal pertains to ads already identified (contents are "stored in advance" in contents DB 33), and is therefore not used to determine ads using content-relevance information. Accordingly, claims 1, 8 and 15 are not anticipated by the Ogura patent for at least this additional reason. Since claims 2-7 depend, either directly or indirectly, from claim 1, since claims 9-14 depend, either directly or indirectly, from claim 8, and since claims 16-21 depend, either directly or indirectly, from claim 15, these claims are similarly not anticipated by the Ogura patent.

During the telephone interview, while the Examiner appreciated this difference, she felt that this difference was not adequately defined in the claims.

Although the undersigned believes that the claims do not read on the Ogura publication, the applicants have further clarified this difference in new claims 22-27. More specifically, new claims 22-24 depend from claims 1, 8 and 15, respectively, and further recite that the document is an e-mail document. These claims are supported throughout the application. (See, especially, page 6, lines 20-22 and reference number 630 of Figure 6.) New claims 25-27 depend from claims 1, 8 and 15, respectively, and further recite that the set of one or more ads are determined to be relevant to the content of the document. These claims are supported throughout the application. (See, especially, page 4, lines 17-24 and reference numbers 650 and 660 of Figure 6.) Accordingly, these new claims further distinguish the claimed invention over the Ogura publication

Finally, independent claims 1, 8, and 15 are not anticipated by the Ogura publication at least because the cited portions of the Ogura publication do not teach acts of, or means for, accepting by a content-relevant ad server and/or sending from a client device, the session identifier and **position information**. The Examiner contends that paragraph [0011] and Figures 49, 53 and 54 of the Ogura publication teach this. (See, Paper No. 120505, page 3.) The cited figures merely concern ad information, and acquiring a layout and parts of an ad. The cited paragraph summarizes overall operations in the Ogura publication. Frankly, none of the cited material of the Ogura publication teaches sending from a client device or receiving by a content-relevant ad server, a session identifier and position information. Accordingly, claims 1, 8 and 15 are not anticipated by

the Ogura patent for at least this additional reason. Since claims 2-7 depend, either directly or indirectly, from claim 1, since claims 9-14 depend, either directly or indirectly, from claim 8, and since claims 16-21 depend, either directly or indirectly, from claim 15, these claims are similarly not anticipated by the Ogura patent.

As discussed during the telephone interview with reference to Figures 3 and 5 of the present application, given a single image with multiple ads, the **position information** permits the determination of where, within the image (which includes ad(s)), the user action (e.g., click or selection) occurred. Claims 28-30 depend from claims 1, 8 and 15, respectively, and further recite that (1) the image includes at least two ads, (2) the user action is a user selection of an ad within the image, and (3) the position information is a position of a cursor within the image at the time of a user selection. These claims are supported, for example, by page 5, lines 11-15, page 21, lines 1-4, and reference number 685 of Figure 6. Similarly, new claims 31 and 34, which depend from claims 1 and 15, respectively, further recite that (1) the image includes at least two ads, (2) the user action is a user selection within the image, and (3) the method further includes using the sent session identifier and position information to determine a particular ad that was selected by the user. Thus, these new claims further distinguish the claimed invention over the cited art.

## Amendments to the Specification

The specification has been amended to correct minor errors.

### New claims

New claims 22, 25, 28, and 31-33 depend, either directly or indirectly, from claim 1 and further distinguish the claimed invention over the Ogura publication as described above.

Each of new claims 23, 26 and 29 depends from claim 8 and further distinguishes the claimed invention over the Ogura publication as described above.

New claims 24, 27, 30, and 34-36 depend, either directly or indirectly, from claim 15 and further distinguish the claimed invention over the Ogura publication as described above.

New claims 22-24 are supported throughout the application. (See, especially, page 6, lines 20-22 and reference number 630 of Figure 6.)

New claims 25-27 are supported throughout the application. (See, especially, page 4, lines 17-24 and reference numbers 650 and 660 of Figure 6.)

New claims 28-31 and 34 are supported, for example, by page 5, lines 11-15, page 21, lines 1-4, and reference number 685 of Figure 6.

Finally, new claims 32, 33, 35 and 36 are supported, for example, by page 5, lines 3-18, page 15, lines 28-30 and section 4.2.4.





Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

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